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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91121980
Party	Plaintiff ESTEFAN ENTERPRISES, INC.
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Submission	Motion to Amend Pleading/Amended Pleading
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Date	04/04/2006
Attachments	Bongos Motion for leave to amend Petition to Cancel.pdf (3 pages) Bongos Amended Petition to Cancel.pdf (6 pages)

IN THE UNITED STATES PATENT AND TRADEMARK
OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Opposition No. 91121980
Cancellation No. 92042251

ESTEFAN ENTERPRISES, INC.,
a Florida corporation,

Petitioner/Opposer,

vs.

BONGO, S.A. de C.V. and ROBERTO NOBLE,

Registrants/Applicants.

PETITIONER ESTEFAN ENTERPRISES, INC.'S
MOTION FOR LEAVE TO AMEND PETITION TO CANCEL

Petitioner, Estefan Enterprises, Inc., pursuant to T.B.M.P. 322, requests leave to amend its Petition to Cancel and states as follows:

1. Petitioner seeks to amend its Petition to Cancel to assert an additional basis for cancellation of Registrant's COCO BONGO mark the claim that Registrant is not using the mark COCO BONGO for each service listed in its registration. Specifically, Registrant's U.S. COCO BONGO registration is based on its Mexican registration, which is described as in use for the following services: restaurant, self-service restaurant, cafeteria, canteen, night club, and snack-bar services. In its U.S. application based on its Mexican registration, Registrant falsely declared under oath that it was in fact using the mark in connection with all of the services listed in the Mexico registration. However, as EEI learned at the deposition of the corporate representative of Registrant, Bongo, S.A. de C.V. taken on September 2, 2005, Registrant has never offered

restaurant, self-service restaurant or cafeteria services and does not regularly offer snack bar services under the COCO BONGO mark in Mexico.

2. “Pleadings in a cancellation proceeding may be amended in the same manner and to the same extent as in a civil action in the United States district court.” 37 C.F.R. 2.107. Under Fed. R. Civ. P. 15(a), “leave shall be freely given when justice so requires.” Fed.R.Civ.P. 15(a). “[A]mendments to pleadings should be allowed with great liberality at any stage of the proceeding where necessary to bring about a furtherance of justice unless it is shown that entry of the amendment would violate settled law or be prejudicial to the rights of any opposing parties.” T.B.M.P. §507.02; American Optical Corp. v. American Olean Title Co., Inc., 168 U.S.P.Q. 471, 473 (TTAB 1971) (emphasis added); Commodore Electronics Limited v. CBM Kabushiki Kaisha, 26 U.S.P.Q. 2d 1503 (TTAB 1993). Registrant will not be prejudiced by proposed amendment. Resistant has had ample notice of this claim since it was specifically raised in EEI’s Supplement to Motion for Summary Judgment filed on September 27, 2005.

3. Moreover, although the facts surrounding this claim are entirely within Registrant’s own knowledge, the discovery period in this proceeding does not close until May 1, 2006. Accordingly, Registrant should be given leave to file an Amended Petition to Cancel as an amendment at this stage in the proceedings is wholly proper. *See e.g., Polaris Industries v. DC Comics*, 59 USPQ2d 1789 (TTAB 2001) (granting leave to amend opposition prior to close of discovery); *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221, 1222 (TTAB 1993) (applicant would not be prejudiced by amended pleading because the proceeding was still in the pre-trial phase and discovery was ongoing); Space Base, Inc. v. Stadis Corporation, 17 U.S.P.Q. 2d 1216 (TTAB 1990) (granting motion to leave to amend opposition after answer and affirmative defenses filed, counterclaim was filed and discovery had begun).

4. Undersigned counsel has in good faith conferred with opposing counsel regarding the relief sought in this Motion, and opposing counsel has indicated that he opposes the relief sought herein.

5. EEI's proposed Amended Petition to Cancel is attached hereto.

WHEREFORE, Petitioner, Estefan Enterprises, Inc., requests leave to amend its Petition to Cancel.

Respectfully Submitted,

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By: /Karen L. Stetson/
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CERTIFICATE OF MAILING

I HEREBY CERTIFY that the foregoing has been sent via U.S. Mail to Michael Santucci, Esq., Silverman Santucci, LLP, 500 West Cypress Creek Road, Suite 500, Fort Lauderdale, Florida 33309 on this 4th day of April, 2006.

By: /Karen L. Stetson/
Karen L. Stetson

IN THE UNITED STATES PATENT AND TRADEMARK
OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Opposition No. 91121980
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BONGO, S.A. de C.V. and ROBERTO NOBLE,

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ESTEFAN ENTERPRISES, INC.'S AMENDED PETITION TO CANCEL
REGISTRATION NO. 2347247

Pursuant to 15 U.S.C. §1064 and T.B.M.P. 303.01, Petitioner, Estefan Enterprises, Inc., believes that it is and will be damaged by and hereby petitions to cancel, Registration No. 2347247 and alleges:

1. Petitioner, Estefan Enterprises, Inc., is a Florida corporation with its principal place of business at 420 Jefferson Avenue, Miami Beach, Florida 33139.
2. Registrant, Bongo, S.A. de C.V., is a Mexican corporation with its principal place of business at Lafontaine 110, local 18, Colonia Polanco, C.P. 11560, Mexico, Distrito Federal, MEXICO.
3. On April 1, 2005, Registrant, Bongo, S.A. de C.V., assigned its entire interest in the COCO BONGO mark to Grupo Industrial Hotelero, C.V. On May 10, 2005, Grupo Industrial Hotelero, C.V. in turn assigned its entire interest in the COCO BONGO mark to Roberto Noble. Roberto Noble is the current owner of the COCO BONGO mark, U.S. Registration Number 2347247.

4. Petitioner owns U.S. trademark registration for the following mark in International Class 042:

BONGOS CUBAN CAFE U.S. Registration Number 2490999 for restaurant and bar services in International Class 042.

5. Petitioner has six (6) other federal trademark registrations for the mark BONGOS CUBAN CAFE (and Design) for souvenir clothing and other items, U.S. Registration Nos. 2494542, 2498561, 2521175, 2523448, 2523449 and 2676897.

6. Petitioner is an entity that was founded and owned by Gloria and Emilio Estefan.

7. Petitioner is closely associated with its principals, the husband and wife team of Emilio and Gloria Estefan. Gloria Estefan is a world-renowned, internationally acclaimed singer and songwriter. Throughout the course of Ms. Estefan's career in the music industry, Ms. Estefan has become known worldwide for her Latin-themed music and has received numerous awards for records and albums that have reached the top ten and number one spots on the Latin, Dance and Pop music charts. Emilio Estefan, Jr. is a world-renowned music producer and songwriter, who has received numerous awards for his work.

8. From at least as early as September 14, 1997 and continuing to date, pursuant to grants of rights from Petitioner, Bongos Cuban Cafe, Inc. ("BCC") and Bongos Cuban Cafe Miami, Inc. ("BCCM") (hereafter the "Bongos Group") operate Cuban-themed restaurant/nightclubs under the BONGOS CUBAN CAFE mark in Lake Buena Vista, Florida and Miami, Florida, respectively. The Bongos Cuban Cafe in Miami, Florida occupies 15,000 square feet and two floors of indoor and outdoor dining areas and two large bar areas. The Bongos Cuban Cafe in Lake Buena Vista, Florida occupies 16,000 square feet and seats approximately 550 people.

9. The Bongos Group, including Petitioner, has spent substantial time, money and effort in promoting BONGOS CUBAN CAFE mark. One Bongos Group restaurant/nightclub operating under the name and mark BONGOS CUBAN CAFE is located in Downtown Disney, within Walt Disney World, an attraction visited by millions yearly. Another Bongos Group restaurant/nightclub operating under the name and mark BONGOS CUBAN CAFE is located in Miami, Florida, a popular tourist and business destination.

10. As a result of the restaurant and bar and entertainment services provided by the Bongos Group and its founders, Gloria and Emilio Estefan, the name and mark BONGOS CUBAN CAFE has become a strong, well and favorably known designation of origin to the general public throughout the United States for the goods and services of the Bongos Group, and Petitioner has established extensive goodwill and public recognition for the BONGOS CUBAN CAFE mark as an exclusive identification of the services offered and sold by Petitioner.

11. Noble owns U.S. trademark registration for the following mark in International Class 042:

COCO BONGO U.S. Registration Number 2347247 for restaurant, self-service restaurant, cafeteria, canteen, night club and snack-bar services in International Class 042.

12. The COCO BONGO mark was obtained on the basis of a foreign (Mexican) counterpart registration pursuant to Section 44 of the Lanham Act, 15 U.S.C. §1126(e).

13. Registrant filed its application in Mexico on August 21, 1998 and filed its application in the United States on July 13, 1999.¹ Registrant obtained its U.S. registration for its COCO BONGO mark on May 2, 2000.

¹ Pursuant to Section 44(e) of the Lanham Act, in order to be accorded the same force and effect as would be accorded to Registrant if filed in the United States on the same date on which the application was first filed in such foreign country, Registrant was required to file its trademark application in the United States within six (6) months from the date on which the application was first filed in the foreign country (Mexico). Registrant did not follow such

14. There is no issue as to priority. The COCO BONGO application was filed under Section 44 of the Lanham Act, well after Petitioner's filing of the application for the BONGOS CUBAN CAFE and after Petitioner's first use of the mark for restaurant and bar services on September 14, 1997.

GROUNDS FOR THIS PETITION

15. The grounds for cancellation are as follows:

(a) Abandonment

16. Registrant and Noble have abandoned the COCO BONGO mark, which was based on a foreign registration, as it has never been used in commerce in the United States since the COCO BONGO application was filed six (6) years ago in 1999. Registrant did not have a bona fide intent to begin use of the mark when it filed its trademark application on July 13, 1999 in the United States and has merely attempted to reserve a right in the mark.

(b) Fraud in the Procurement of its Registration

16. The COCO BONGO mark is subject to cancellation as Registrant falsely declared under oath in its U.S. application based on its Mexican registration that it was in fact using the mark in connection with all of the services listed in the Mexico registration.

17. Registrant's U.S. COCO BONGO registration is based on its Mexican registration, which is described as in use for the following services: restaurant, self-service restaurant, cafeteria, canteen, night club, and snack-bar services.

18. Registrant or Noble have never offered restaurant, self-service restaurant or cafeteria services and does not regularly offer snack bar services under the COCO BONGO mark in Mexico.

requirements. Instead, Registrant filed its United States application approximately 11 months after it filed its Mexican application.

19. Registrant knew or should have known at the time it submitted its application that the mark was not in use on all of the goods and services listed in the Mexican registration.

(c) Likelihood of Confusion

20. Registrant's trademark consists of a name previously used in the United States, as to be likely, when used on or in connection with the services of Petitioner, to cause confusion, or to cause mistake, or to deceive. Petitioner would be damaged by the above-identified registration as any use by Registrant of the mark COCO BONGO in connection with the advertising and promotion and/or offering of restaurant and bar services is likely to: (a) cause confusion, mistake or deception as to the source or origin of Registrant's services; (b) suggest falsely a sponsorship, connection, license or association of Registrant's services with or by Petitioner and its founders Gloria and Emilio Estefan and; (c) cause serious and irreparable damage to the reputation and goodwill of Petitioner in its BONGOS CUBAN CAFE mark, for which Petitioner has no adequate remedy at law.

WHEREFORE, Petitioner, Estefan Enterprises, Inc., requests that Registration No. 2347247 be cancelled and that this Amended Petition to Cancel be sustained in favor of Petitioner.

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By: /Karen L. Stetson/
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